Remarks

In the present application, claims 1-20 are pending. Claims 1-20 are rejected.

Amendment to the Claims

Claims 1-6 are amended with merely clarifying amendments. Support for these clarifying amendments may be found throughout the specification, for example, pages 9, line 27 – page 10, line 28 ("it is checked in step 402 whether the dialogue is to be traced, i. e. whether the subscriber is included in the monitoring table"; "it is checked in step 408 whether the message belongs to a dialogue related to the subscriber"; "it is checked whether the dialogue is on the list of the dialogues to be traced"; "If the message is the last message, we proceed to step 411 where the dialogue is removed from the list of dialogues to be traced"; "If the dialogue is to be traced, it will be added to the list of dialogues to be traced in step 403"; and "in step 401 it is checked whether the message initiates a dialogue").

Claim 7-20 are canceled without prejudice or disclaimer.

Claims 21-34 are newly added. Support for these claims may be found throughout the specification and the claims as originally filed, for example, page 6, lines 17-18 ("existing network elements comprise processors and memory which the functions of the invention can employ").

No new matter is added.

Claim Rejections - 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-20 under 35 U.S.C. § 102(e) as anticipated by Remy (U.S. Patent Publication No. 6,091,950), herein Remy. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1-6, as well as a favorable consideration of newly added claims 24-34.

These rejections are respectfully disagreed with, and are traversed below.

The Examiner is respectfully reminded that for a rejection to be made under 35 U.S.C. § 102(e), it is well recognized that "to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art", *Ex Parte Gould*, BPAI, 6 USPQ 2d, 1680,

1682 (1987), citing with approval *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978).

Regarding claim 1, which recites:

"A method, comprising:

"receiving a signaling message in a functional entity for subscriber mobility management in a mobile communication system;

"receiving a trace command, the trace command **identifying at least one subscriber** whose signaling messages are to be traced and **identifying a tracer** to which information obtained during tracing is sent; and

"**in response to determining** that the signaling message is related to the at least one subscriber, **sending**, from the functional entity to the tracer, a copy of the signaling message, wherein the copy of the signaling message sent to the tracer is identical to the received signaling message" (emphasis added).

The Examiner asserts that Remy teaches:

"receiving a trace command in said functional entity (since there are multiple protocol analyzers 221 – 223 within the group 21 it is **inherent** to one of ordinary skill in the art to recognize that each pre-programmed protocol analyzers are **capable of monitoring** a particular interface respectively, thus each protocol analyzers have programmed within a trace command), the command identifying at least one subscriber (interface) whose signaling messages are to be traced (the group 21 **records signaling information traveling through at least one interface**; Col. 8, lines 37 – 43) and indicating a tracer (signaling data base; Fig. 2, element 24) to which information obtained during tracing is sent (the group 21 **transmit the signaling information towards the signaling data base 24**; Col. 8, lines 53 – 55)"

With respect to inherency, MPEP §2112(IV) states:

"The fact that a certain result or characteristic **may occur or be present** in the prior art is **not sufficient to establish the inherency** of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)...

""In relying upon the theory of inherency, the **examiner must provide a basis in fact and/or technical reasoning** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)" (emphasis added).

As argued, "each pre-programmed protocol analyzers **are capable of** monitoring a particular interface". Thus, the arguments presented (which the Applicant does not assert are correct), state that "monitoring a particular interface" "**may** occur or be present". There is no "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows". Accordingly, the arguments based on inherency are improper.

The Examiner asserts that Remy teaches: "the command identifying at least one subscriber (interface) whose signaling messages are to be traced (the group 21 records signaling information traveling through at least one interface; Col. 8, lines 37 – 43)".

Assuming, arguendo, that Remy teaches "the group 21 records signaling information traveling through at least one interface" (which the Applicant does not so assert), this does not disclose or suggest a "trace command" which identifies a "subscriber" (let alone a subscriber "whose signaling messages are to be traced"). Rather, this asserts the group "records signaling information" without addressing the contents of a "trace command". There is no disclosure or suggestion that the "protocol analyzers" are provided with a command that identifies which "interface" to trace.

Likewise, the assertion that Remy teaches: "a **tracer** (signaling data base; Fig. 2, element 24) to which information obtained during tracing is sent (the group 21 transmit the signaling information towards the signaling data base 24; Col. 8, lines 53 – 55)", also does not disclose or suggest a "trace command" which **identifies** a "tracer".

Clearly, Remy does not disclose or suggest "receiving a trace command, the trace command identifying at least one subscriber whose signaling messages are to be traced and identifying a tracer to which information obtained during tracing is sent" as in claim 1.

There is no suggestion that Remy teaches "in response to determining that the signaling message is related to the at least one subscriber, sending, from the functional entity to the

tracer, a copy of the signaling message, wherein the copy of the signaling message sent to the tracer is identical to the received signaling message". Remy does not disclose or suggest performing any action "in response to determining that the signaling message is related to the at least one subscriber", the subscriber identified in "the trace command" as in claim 1.

As Remy does not disclose or suggest all elements of claim 1, Remy does not anticipate claim 1. For at least this reason, claim 1 is in condition for allowance. Claims 2-6 depend upon claim 1. For at least this reason, they are likewise in condition for allowance. Further, and based on the foregoing arguments, it is submitted that the disclosure of Remy does not suggest or render obvious to one skilled in the art the subject matter of claim 1.

Regarding claims 3-5, the Examiner again argues "it is inherent to one of ordinary skill in the art to recognize...". Should the Examiner maintain these rejections, the Applicant respectfully requests the Examiner provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows" in order to ensure such arguments based on inherency are proper.

The Examiner is respectfully requested to reconsider and remove the rejection under 35 U.S.C. § 102(e) based on Remy, and to allow claims 1-6.

As newly added claims 21, 27 and 33 recite similar language to that discussed above with reference to claim 1; claims 21, 27 and 33 are likewise in condition for allowance. Newly added claims 22-26, 28-32 and 34 depend upon claims 21, 27 and 33. For at least this reason, they are likewise in condition for allowance.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.
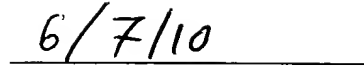
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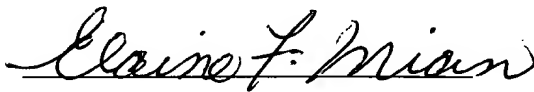
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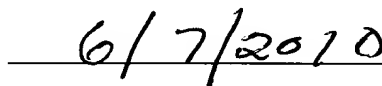
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